



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,153	10/02/2000	Steven J. Sculler	M&R-3.0-033-CIP	3874

530 7590 06/19/2003

LERNER, DAVID, LITTENBERG,
KRUMHÖLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

RHODE JR, ROBERT E

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/677,153

Applicant(s)

SCULLER ET AL. 10 SEPTEMBER

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-112 is/are pending in the application.
- 4a) Of the above claim(s) 45 - 74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 75 - 112 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Restriction Requirement in Paper No. 7 is acknowledged. Additionally, it is acknowledged that applicant reserves the right to file a divisional application corresponding to the non-elected claims.

Drawings

The drawings filed on 10/02/2000 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 75 – 78, 80 – 82, 84 – 90, 93, 96 – 103 and 111 - 112 are rejected under 35 U.S.C. 102(e) as being unpatentable over Mellgren III (US 6,085,126).

Regarding claim 75 and related claims 96, 102, 103 and 111 (NEW), Mellgren teaches a method of obtaining information about a personalized product to be provided from a provider to an organization, the personalized product displaying information provided by the organization, the method comprising the provider: receiving instructions over a network from a first user within the organization, the instructions defining which aspects of the information have values which may be changed by a second user within the organization such that the instructions define at least one aspect which may be changed and at least one aspect which may not be changed (see at least Abstract and Figures 3, 7 – 20); transmitting to the second user over the network the values of aspects and an indication, in accordance with the instructions, distinguishing the aspects which the second user may change from those which the second user may not change (see at

least Abstract, Col 3, lines 43 - 54 and Figures 3, 7 - 20); and receiving from the second user over the network the value of an aspect which may be changed in accordance with the instructions and which has changed from the transmitted value (see at least Abstract, Col 5, lines 1 - 49 and Figures 1 and 2).

Regarding claim 76 (NEW), Mellgren teaches a method wherein the step of transmitting includes sending the list in a web page to the second user (see at least Figures 3 and 7 - 20).

Regarding claim 77 (NEW), Mellgren teaches a method wherein the information to be displayed comprises graphics or text to be personalized on the product (see at least Figures 7 - 20).

Regarding claim 78 (NEW), Mellgren teaches a method wherein the product is a stamp (Col 3, line 45).

Regarding claim 80 (NEW), Mellgren teaches a method wherein the aspect includes the content of the information (see at least Figures 7 - 20).

Regarding claim 81 (NEW), Mellgren teaches a method wherein the aspect includes how the information should be formatted (see at least Col 5, line 33) and (82) wherein

the formatting relates to one of more of the font, font size, font style, position or alignment of the information (Col 5, line 35).

Regarding claim 84 (NEW), Mellgren teaches a method wherein the information constitutes a picture chosen by a user (see at least Col 4, lines 23 – 25 and Figures 2, 6 – 8 and 24).

Regarding claim 85 (NEW), Mellgren teaches a method further including at least one of the users modifying the instructions so as to modify whether an aspect may be changed or not (Col 5, lines 1 – 14 and Figures 7 – 10) and (86) further comprising the first user modifying the instructions so as to modify whether an aspect may be changed or not (see at least Col 5, lines 1 – 49 and Figures 7 – 20) as well as (87) further comprising the second user modifying the instructions so as to modify whether an aspect may be changed or not (see at least Col 5, lines 1 – 49 and Figures 7 – 20).

Regarding claim 88 (NEW), Mellgren teaches a method wherein the step of modifying the instructions comprises sending a web page to the at least one user listing the aspect to be changed and allowing the user to click a control to change the instructions associated with the aspect (see at least Figures 7 – 20) and (89) wherein the control is a checkbox (see at least Figures 7 – 9).

Regarding claim 90 (NEW), Mellgren teaches a method wherein the indication is the appearance of the area for accepting user input of the value (see at least Figure 12).

Regarding claim 93 (NEW), Mellgren teaches a method wherein the first user and the second user are different people (See at least Figure 1).

Regarding claim 97 (NEW), Mellgren teaches a method further comprising, after the step of receiving, sending a web page to the client describing the first aspect and, if the first aspect is locked then the web page displays the value of the aspect and, if the aspect is unlocked, then the web page indicates that the value of the aspect may be changed (see at least Figures 1, 2 and 7 – 20).

Regarding claim 98 (NEW), Mellgren teaches a method wherein at least one of the aspects relates to the content of personalization information to be affixed to a stamp and the value of the at least one aspect relates to the content (see at least Figures 7 – 14) and (99) a method wherein the content identifies an entity (see at least Figure 13).

Regarding claim 100 (NEW), Mellgren teaches a method wherein the aspect relates to the formatting of personalization information to be affixed to a stamp (see at least Figures 13 – 15).

Art Unit: 3625

Regarding claim 101 (NEW), Mellgren teaches a method wherein, if the aspect is unlocked, then the web page also displays the value of the aspect (see at least Figures 1 and 7 – 10).

Regarding claim 112 (NEW), Mellgren teaches a method wherein the sent data includes information relating to where the aspects are displayed on the product (see at least Figure 24).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 94 and 109 - 110 are rejected under 35 U.S.C. 102(e) as being unpatentable over Barnes (US 5,970,475).

Regarding claim 94 (NEW) and related claims 109 and 110 (NEW), Barnes teaches a method further comprising associating a login or password with the instructions, and wherein the instructions cannot be changed by the first user or second user unless the

first user or the second user had provided a valid login or password (see at least Col 14, lines 19 – 24 and Figure 9 and 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 79, 83, 91, 92 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellgren (US 6,085,126) in view of Farros (US 5,930,810).

Mellgren substantially teaches the applicant's invention as disclosed.

However, Mellgren does not specifically disclose and teach a method wherein the product is an advertising specialty and a method wherein the information constitutes a logo as well as a method wherein a three dimensional textbox indicates that the aspect may be changed. Nor does Mellgren specifically disclose and teach, a method wherein the first user and the second user are the same person or a method further comprising displaying the personalized information simultaneously with the aspect values to the second user.

On the other hand and regarding claim 79 (NEW), Farros teaches a method wherein the product is an advertising specialty (Col 2, lines 32 – 33).

Regarding claim 83 (NEW), Farros teaches a method wherein the information constitutes a logo (Col 2, lines 32 – 33).

Regarding claim 91 (NEW), Farros teaches a method wherein a three dimensional textbox indicates that the aspect may be changed (Col 2, lines 40 – 41).

Regarding claim 92 (NEW), Farros teaches a method wherein the first user and the second user are the same person (see at least Abstract).

Regarding claim 95 (NEW), Farros teaches a method further comprising displaying the personalized information simultaneously with the aspect values to the second user (Col 2, lines 55 – 65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Mellgren with the method and system of Farros to have enabled a method wherein the product is an advertising specialty and a method wherein the information constitutes a logo as well as a method wherein a three dimensional textbox indicates that the aspect may be changed as well as a method wherein the first user and the second user are the same person and too a method

further comprising displaying the personalized information simultaneously with the aspect values to the second user - in order to have enabled a method which permits a user to modify a printed product by incorporating various personalization features. In this regard, the user has various approaches to personalizing a product – which will increase their satisfaction as well as increase the probability that they will continue to use for future needs.

Claims 104 – 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellgren (US 6,085,126) in view of Barnes (US 5,970,475).

Regarding claim 104 (NEW), Mellgren teaches a method of receiving personalized information to be displayed on a product, the personalization information having aspects, the aspects having values, the method comprising: receiving locking instructions from a first user, whereby if the instructions identify an aspect as being locked, then the value cannot be changed until the aspect is unlocked (see at least Figures 7 – 20); sending values of aspects to a second user and indicating whether the aspect is locked, at least one of the aspects being locked (see at least Figures 1, 2 and 7 – 20). In addition and regarding claim 105 (NEW), Mellgren teaches a method further comprising indicating which values are unlocked during the step of sending the values (figures 7 - 10) and (107) a method wherein the step of sending further includes placing the value in a user modifiable textbox to indicate that the value's associated aspect is unlocked (see at least Figures 7 – 12).

However, Mellgren does not specifically disclose and teach receiving an instruction from a second user to unlock a locked aspect; resending the value of the prior locked aspect to the second user with an indication that the value may now be changed; and receiving the value of the prior locked aspect.

On the other hand, Barnes does disclose and teach receiving an instruction from a second user to unlock a locked aspect (see at least Col 6, lines 54 – 65); resending the value of the prior locked aspect to the second user with an indication that the value may now be changed (see at least Col 6, lines 4 – 65); and receiving the value of the prior locked aspect (see at least Col 8, lines 28 – 35 and Figures 5, 6A, and 13). Moreover:

regarding claim 106, Barnes teaches a method of receiving an instruction from a second user to unlock a locked aspect; resending the value of the prior locked aspect to the second user with an indication that the value may now be changed; and receiving the value of the prior locked aspect (see at least Col 8, lines 28 – 35).

Regarding claim 108(NEW), Barnes teaches a method further including enabling one of the users to unlock an aspect and disabling the other user from unlocking the same aspect (see Col 8, lines 28 – 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Mellgren with the method of Barnes to have enabled a method of receiving personalized information to be displayed on a product, the personalization information having aspects, the aspects having values, the method comprising: receiving locking instructions from a first user, whereby if the instructions identify an aspect as being locked, then the value cannot be changed until the aspect is unlocked; sending values of aspects to a second user and indicating whether the aspect is locked, at least one of the aspects being locked and receiving an instruction from a second user to unlock a locked aspect; resending the value of the prior locked aspect to the second user with an indication that the value may now be changed; and receiving the value of the prior locked aspect – in order to have provided the capabilities to control the areas within a personalized product which can be changed. In this regard, the organization can control the areas within the product, which can be personalized, and by whom as well as providing the security and access control/monitoring to designated areas to assure that the information meets a users requirements. Moreover, the method and system provide the capability of control over suppliers to ensure that the requirements are fulfilled as well as ensuring that users and suppliers have access to only the areas needed. In this manner, the organization will benefit by reducing cost through direct connecting of suppliers with customers – without losing control by the parent organization.

Art Unit: 3625

Conclusion

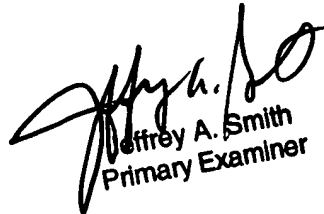
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7658 for regular communications and 703.308.3687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER

June 13, 2003



Jeffrey A. Smith
Primary Examiner